

DEAV2003/0002 US NP
Application No. 10/751,545

PATENT

Remarks/Arguments

Upon entry of the foregoing amendments, claims 1 to 9 will be pending in the present patent application. Claims 1 to 4 and 6 have been amended, without prejudice. Claims 10 and 11 have been canceled, without prejudice.

In view of the foregoing amendments and the following remarks, reconsideration and withdrawal of the objections and rejections are respectfully requested.

Discussion of the Rejection under 35 U.S.C. § 112, First Paragraph

Claims 4 to 6, 10, and 11 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly lacking enablement. (Action at 2). Although applicants respectfully disagree that Claims 4 to 6, 10, and 11 are not enabled by the present specification, Claims 4 to 6 have been amended such that osteoarthritis is the disease treated with the compounds of the present invention and Claims 10 and 11 have been canceled, thus rendering the rejection moot. Accordingly, reconsideration and withdrawal of the rejection are requested respectfully.

Discussion of the Rejections under 35 U.S.C. §§ 101 and 112, Second Paragraph

Claims 10 and 11 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite (Action at 8 to 9). Claims 10 and 11 are also rejected under 35 U.S.C. § 101 as being allegedly improper process claims (Action at 9). Although applicants respectfully disagree with the rejections, Applicants submit respectfully that the foregoing amendments render the rejections moot. Accordingly, reconsideration and withdrawal of the rejections are requested respectfully.

Discussion of the Rejection under 35 U.S.C. § 102(b)

Claims 1, 2 and 4 to 11 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by International Application Publication No. WO02/064571 to Barvian et al. ("Barvian") (Action at 9). Although Applicants respectfully disagree with the rejection, Applicants submit that the foregoing amendments render this rejection moot. Accordingly, reconsideration and withdrawal of the rejection are requested respectfully.

Discussion of the Rejection under 35 U.S.C. § 103(a)

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Claims 1 to 11 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,933,298 to Weithmann et al. ("Weithmann") (Action at 11). Applicants submit respectfully that, because the subject matter of Weithmann and the claimed invention were commonly owned at the time of the invention, the rejection based upon Weithmann is improper under 35 U.S.C. § 103(c) and, therefore, should be withdrawn.

The present application was filed on January 5, 2004 and claims priority benefit under 35 U.S.C. § 119(a) to foreign application DE 10300017.8, filed on January 3, 2003 ("the DE 017 application"). A certified copy of the DE 017 application was submitted on January 5, 2004 pursuant to 37 C.F.R. § 1.55(a) and a Certified English translation of the DE 017 application was submitted on December 16, 2003 in the file of U.S. provisional patent application serial No. 60/472,765, to which the present application also claims priority. Applicants' claim for priority was acknowledged in the Action.

Weithmann issued on August 23, 2005 and has an effective filing date of February 22, 2002, *i.e.*, before the earliest effective priority date of the present application (January 3, 2003). In this regard, the Office Action acknowledges that Weithmann is available as a reference under 35 U.S.C. § 102(e) (Action at 11).

35 U.S.C. § 103(c), however, states that

[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person

(emphasis added). Without commenting on the merits of the rejection under 35 U.S.C. § 103(a), Applicants submit that the subject matter of Weithmann and the claimed invention were commonly owned by Aventis Pharma Deutschland GmbH ("Aventis") or its predecessor in interest *at the time the present invention was made*. Since the subject matter of Weithmann and the claimed invention were commonly owned by Aventis or its predecessor in interest at the time the present invention was made, Weithmann is not available to preclude patentability under 35 U.S.C. § 103(a). Accordingly, Applicants submit respectfully that the rejection must be withdrawn in view of 35 U.S.C. § 103(c).

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Discussion of the Double Patenting Rejections

Claims 1 to 11 have been rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1 to 17 of U.S. Patent No. 6,913,298 to Weithmann et al. (Action at 12 to 13). Applicant requests that this rejection be deferred pending some identification of allowable subject matter, as it likely can be readily resolved (depending upon the subject matter ultimately allowed) through the filing of a suitable terminal disclaimer.

Claims 1 to 12 are provisionally rejected under the judicially created doctrine of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1 to 12 of copending U.S. Application No. 10/700,273 to Klingler et al. ("the Kilinger application") (Action at 13). Although Applicants disagree that the claims of the Klinger application render the present claims obvious, Applicants request that this provisional rejection be deferred pending some identification of allowable subject matter, as it likely can be readily resolved (depending upon the subject matter ultimately allowed) through the filing of a suitable terminal disclaimer.

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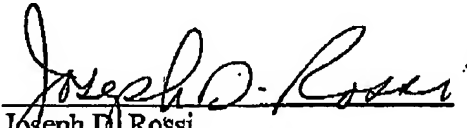
Conclusion

Applicants respectfully submit that this application is now in condition for allowance. Accordingly, an indication of allowability and an early Notice of Allowance are respectfully requested. If there are any issues that can be resolved by a telephone conference or an Examiner's amendment, the Examiner is invited to call the undersigned attorney at (908) 231-3410.

The Commissioner is hereby authorized to charge the fee required and any additional fees that may be needed to Deposit Account No. 18-1982 in the name of Aventis Pharmaceuticals Inc.

Respectfully submitted,

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